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EXAMINER	
SHAY, B	

ART UNIT	PAPER NUMBER
3311	18

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33M1/0708

DATE MAILED: 07/08/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on April 11, 1997 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 60-72 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1-59 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☑ Claims 60-72 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 60-72 are rejected under 35 U.S.C. § 103 as being unpatentable over Peyman in view of Eisenberg. Peyman teaches a system as claimed except for the particular light source and optical fiber material. Eisenberg teaches the desirability of using an Erbium laser for tissue repair ~~or~~ removal. It would have been obvious to the artisan of ordinary skill to employ an ~~Erikle~~ Er:YLF laser to perform the surgery since ~~there~~ this is appropriate for tissue removal and repair, as taught by Eisenberg and to use ~~Holman~~ Holmium, Erbium, and Thulium as the ~~layering~~ lasing ions core, since ~~this~~ these are known to produce wavelength the in the ranges disclosed by ~~Peperman~~ Peyman, judicial notice of which is hereby taken, are equivalents, are not critical, and provide no unexpected result; to employ YLF or YAG as the crystal substrates, since these are widely used as substitutes for lasing ions judicial notice of which is hereby taken are equivalent and produce

no unexpected result; to employ a ~~how~~ low hydroxyl ~~icon~~ ion content fiber, since these were commercially available and known to ~~treatment~~ transmit the desired wavelength at the time of the ~~conventions~~ invention and to employ the claimed pulse width and repetition rates, since these are not critical, are well known in the art, and would provide efficient tissue removal or repair without excessive heating of surrounding tissue for the disclosed irradiated area, judicial notice of which are hereby taken, thus producing a device such as claimed.

Claims 60-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-9, and 15-41 of U.S. Patent No. 4,950,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to include various unclaimed structures (e.g. focussing lens at ~~provisional~~ proximal fiber end and diameter of surgical ~~sits~~ site as they are conventional in the art is thought, ~~this~~ thus producing a device such as claimed.

Claims 60-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16. 60-72 of U.S. Patent No. 4,917,084. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to include various unclaimed structures which are inherently necessary (e.g. means for coupling the laser energy to the fiber) or conventional (e.g. means attached to the distal end of the fiber directing the laser energy ...) thus providing a device such as

claimed.

Claims 60-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 5,196,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially same reasons ~~resume~~ set forth in the double patenting rejection concerning U.S. Patent number 4,950,266.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The claims are additionally rejected under non-statutory, no obviousness type double patenting over the claims and patents set forth above as set forth in In re Schneller 397 F. 2d 350,158 USPQ 210 (CCPA 1962).

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw
July 2, 1997

JENNIFER BAHR
PRIMARY EXAMINER
GROUP 3300